

REMARKS

This is in response to the non-final Official Action currently outstanding with regard to the above-identified application.

Claims 1-28 are pending in the above-identified application. Claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, and 28 stand withdrawn from further prosecution in the above-identified application. Claim 26 is amended so as to maintain uniformity in the terminology utilized therein. Applicants do not propose the cancellation, the addition or the withdrawal of any additional claims. Accordingly, upon the entry to the foregoing Amendment, Claims 1-6, 8, 10, 12, 14, 16, 18, 22, 24 and 26 as hereinabove amended will constitute the claims under active prosecution in this application.

The claims of this application as they currently stand are set forth above including appropriate status identifiers for the convenience of the Examiner.

Applicants appreciate the Examiner's thorough examination of the subject application. Nevertheless, Applicants respectfully **traverse** the currently outstanding grounds for rejection and respectfully request reconsideration of the subject application based on the following Remarks.

More specifically, in the currently outstanding Official Action the Examiner has:

1. Failed to re-acknowledge Applicants' claim for foreign priority under 35 USC §119 (a)-(d) or (f), and to reconfirm the receipt by the United States Patent and Trademark Office of the required copies of the priority documents; -
These matters were acknowledged in the previous Official Action and are referred to here solely for the sake of clarity in the record.

2. Indicated that the drawings as filed with this application on 1 August 2001 are accepted;
3. Acknowledged Applicants' Information Disclosure Statement of 26 May 2006 by providing Applicants with a copy of the Form PTO/SB/08a/b that accompanied that Information Disclosure Statement signed, dated and initialed in confirmation of his consideration of all but one of the references listed therein (the one reference apparently not considered is crossed out by the Examiner on the copy of the Form PTO/SB/08a/b provided to Applicants) – **Applicants' return receipt postcard with respect to the Information Disclosure Statement of 26 May 2006 indicates that all twelve (12) references listed on the Form PTO/SB/08a/b were duly received by the United States Patent and Trademark Office (see copy attached). Accordingly, Applicants cannot explain why the Examiner apparently did not receive one of the cited references. A copy of the crossed out reference is being provided again herewith along with a new Form PTO/SB/08a/b and applicant respectfully requests that the Examiner sign, date, initial and return the enclosed Form PTO/SB/08a/b to Applicants in confirmation of his consideration of the reference originally submitted with the Information Disclosure Statement of 26 May 2006 but apparently lost by the United States Patent and Trademark Office.**
4. Rejected claims 1-6, 8, 10, 12, 14, 16, 18, 22 and 24 under 35 USC §103(a) as being unpatentable over the Mazzagatte et al. reference (US Patent 6,862,583) in view of the Francis et al. reference (US Patent 6,650,430) further in view of the Relly reference (US Pub. 2003/0126328;

5. Rejected claim 20 under 35 USC 103(a) as being unpatentable over the Mazzagatte reference in view of the Francis reference further in view of Reilly reference, further in view of the Peters reference (US Patent 6,601,093), and
6. Rejected claim 26 under 35 USC 102(e) as being anticipated by the Mazzagatte et al reference in view of the Reilly reference.

Further comment regarding items 1-3 above is not deemed to be required in these Remarks.

With regard to items 4-6, on the other hand, Applicants support for their traversal of the Examiner's currently outstanding rejections and request for reconsideration is as follows.

The primary features of the present invention reside in that print data that is commanded by a personal computer or the like to be printed out is held in a storage device associated with the printer without being printed out, and information that identifies the so held print data is stored in the user's portable storage device. When the user having the data storage device in his possession approaches the target printer, the printer senses the existence of the information identifying the print data that is stored in the storage device, and the so identified the print data held in the printer then starts to print out. More specifically, the approach of the user who has a storage device in which the information identifying the print data in his possession allows the printer to carry out (i) the identifying of the print data, based on information identifying the print data, stored in the storage device and (ii) the print-out of the print data so identified.

On the other hand, the primary reference cited by the Examiner is directed to a technique relating to the authentication of a user who can command outputting of the print data held by the printer. As such, Applicants respectfully submit that the art cited by the Examiner is totally different from the present invention that specifically includes (i) the technique by which the print data is identified based on the information identifying the print data, (ii) the technique by which the print data which has been identified is outputted, and (iii) the printer that carries out the above operation automatically.

Hence, Applicants respectfully submit that with regard to independent Claim 1, it should be noted that the claim recites *inter alia* identification data that uniquely identifies the operation data, and portable storage means for receiving the identification data. This feature is not taught or suggested by any of the presently cited references.

In particular, the Examiner relies upon the Reilly reference as teaching the claimed identification data. Applicants respectfully note, however, that the Reilly reference merely teaches a job ID (which is briefly described in paragraph [0022], and does not appear to be further discussed in the Reilly reference), which is a unique numerical identifier for the print job. The Reilly job ID appears to be used in communication between the host computer and the printer. Significantly, however, as far as Applicants have been able to determine, the Reilly reference fails to teach, disclose or suggest that the job ID is to be communicated to or received by a portable storage means.

To supply a teaching of the portable storage means, the Examiner relies upon the smart card, as taught by the Mazzagate reference. It is respectfully noted, however, that the smart card of the Mazzagate reference merely stores authentication information indicating the user. There is no teaching, disclosure or suggestion in the Mazzagate reference regarding the storage of identification data that uniquely identifies **operation data** in the smart card discussed by the Mazzagate reference.

The Examiner further contends that it would have been obvious to one of ordinary skill in the art at the time that the present invention was made to combine the teachings of the Mazzagatte and Reilly references so as to arrive at the present invention. Applicants respectfully disagree and submit that to the extent that the combination of the Mazzagatte reference and the Reilly reference teach, disclose or suggest anything concerning the present invention, such a conclusion can only be arrived at via improper hindsight reasoning.

Specifically, Applicants respectfully submit that if the Mazzagatte and Reilly references were to be combined (assuming *arguendo* that such a combination is in any way possible or appropriate), the result would be the device of the Mazzagatte reference in which a print job is assigned a numerical job ID such as that disclosed by the Reilly reference. However, Applicants respectfully note that there is no teaching, disclosure or suggestion or motivating factor in the art for the smart card to receive the job ID. Furthermore, it is not at all clear in any case how providing the smart card with the job ID would lead to “using the unique ID to reference print jobs and acquire additional information and status of the print job”, as suggested by the Examiner in the last paragraph of page 4 of the currently outstanding Official Action. As far as Applicants have been able to understand from the art any such acquiring of additional information and status of the print job appears to be performed by the host computer.

Hence, Applicants respectfully submit that it is not at all clear from the cited references how acquiring information and status of the print job would be achieved by providing the job ID of the Reilly reference to the smart card of the Mazzagatte reference. Accordingly, Applicants can find no, and respectfully submit that there is no, motivation within the four corners of the cited art that would cause a user to provide the smart card of Mazzagatte with the job ID of Reilly.

Further, the Examiner cites the Francis reference as teaching “entering information into the memory of the smart card”. Applicants respectfully submit that it is to be recognized, however, that the Francis reference teaches that once the smart card key has been programmed with a password, that password can only be changed under certain selected conditions or circumstances (see column 4, lines 24-28). Accordingly, Applicants respectfully submit that the best that can be said regarding the Examiner’s construction of the Francis reference is that it teaches, discloses or suggests that the changing of information on the smart card should not be easily accomplished.

However, Applicants respectfully submit that in the present circumstances if a job ID is to be stored on the smart card, the information on the smart card would need to be changed for every print job. This clearly would be impractical in the context of printing numerous jobs to the extent that that Applicants respectfully suggest that it is clear that one of ordinary skill in the art at the time that the present invention was made would not have been lead to combine the Mazzagatte, Reilly and Francis references in order to achieve the result achieved by the present invention. Rather, it only has been by utilizing the present invention as a basic framework that the Examiner has been able to pick and chose isolated elements of the prior art so as to recreate the present invention. Such clearly is not an acceptable way to establish the *prima facie* case required to justify the Examiner’s currently outstanding rejections.

Claims 22, 24 and 26 recite similar features to those just discussed with regard to claim 1, and Applicants respectfully submit that the Examiner’s rejections of those claims must fail for reasons similar to those just discussed with regard to Claims 1.

Also, Applicants respectfully note that the Examiner’s rejection of Claim 26 as being anticipated under 35 USC 102(e) is based upon a combination of references. Applicants respectfully submit that such a rejection is not proper because anticipation requires that all of the elements of the claim be found in a single cited reference cooperating with one another in the same manner as claimed.

With respect to claim 20, the Examiner contends that the claimed features are taught by a combination of the Mazzagatte reference and the Peters reference (in addition to the Francis and Reilly references discussed above). Applicants respectfully submit in this regard, however, that the Peters reference merely describes a wireless notebook computer that transmits data to a printer. Accordingly, one skilled in the art desiring to apply the Peters teachings to the device disclosed by the Mazzagatte reference would replace the laptop computer 20 of the Mazzagatte reference with the wireless computer of the Peters reference since the wireless computer of the Peters reference would be performing a similar function to that of the laptop computer of Mazzagatte. However, Applicants respectfully submit that such a substitution has nothing at all to do with the leading one of ordinary skill in the art to replace the smart card of the Mazzagatte reference with the wireless computer of the Peters reference.

Furthermore, the Examiner relies on the Peters reference as providing a teaching of the transmitting of information to a printer. In this regard it will be seen that the Peters reference describes two embodiments, namely, (1) a wireless computer establishing communications with a printer directly (without transmitting the information to a server) and (2) a wireless computer establishing communications with a server (see, Peters at Column 4, lines 41-50). However, a wireless computer establishing a communications with a server does not correspond to a wireless device transmitting information to a printer and thus cannot support the Examiner's position. Further, a wireless computer establishing communications with a printer directly is not compatible with the Mazzagatte reference. The Mazzagatte reference requires that print data be stored on a print node (a server) until authentication is received (see Mazzagatte, Column 2, lines 13-20, for example). However, the combination proposed by the Examiner would require print data to be sent directly to the printer from the wireless computer, contrary to the express teachings of the Mazzagatte reference. Accordingly, Applicants respectfully submit that the combination of the Mazzagatte and Peters references is not suggested to one skilled in the art as the Examiner has asserted.

Still further and also contrary to the Examiner's assertions in the currently outstanding Official Action, Applicants respectfully submit that the art relied upon in support of the currently outstanding rejections does not teach, disclose or suggest that the identification data is transmitted **automatically** from a portable data storage device when the portable data storage device approaches the claimed electronic device. Instead, in both the Mazzagatte and Francis references, the potential user of the printer is required to actively associate the so-called "small card" with the CPU controlling the operation of the printer. In other words, the user has to insert his "small card" into a small card reader and survive a so-called "challenge/response" sequence prior to the input of the identification information thereon acting to cause the printing of anything. This appears to be true no matter what the proximity relation of the small card reader to the printer may be (note, nothing in the references appears to **require** that spatial relationship between the small card reader and the printer to be a close). The same is true even if the small card transmits its signals via RF instead of being plugged into the small card reader.

Applicants therefore respectfully submit that the Examiner has not satisfied his burden of showing a valid *prima facie* case in support of his assertions that the claims of this application are unpatentable. Accordingly, Applicants respectfully submit that as hereinabove amended the claims of this application now are in condition for allowance. Therefore, entry of the foregoing Amendment and reconsideration and allowance of the present application in response to this communication are respectfully requested

Applicants believe that an extension of time is not required since this response is being filed within the specified time period. The Applicants, however, conditionally petition for a further extension of time to provide for the possibility that such a petition has been inadvertently overlooked and is required. As provided below, charge Deposit Account **04-1105** for any required fee.

Dated: August 21, 2006

Respectfully submitted,

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